Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The final Office Action dated August 9, 2005 indicated that Claim 23 is allowed, and further repeated claim rejections from the previous Office Action in indicating that claims 1-8, 13, 14, 24 and 25 stand rejected under 35 U.S.C. § 103(a) over Edholm (U.S. Patent No. 6,449,269) in view of Dean *et al.* (U.S. Patent No. 5,303,326); claim 9 stands rejected under 35 U.S.C. § 103(a) over Edholm in view of Dean *et al.* as applied to claim 1 above, and further in view of Sugiura *et al.* (U.S. Patent No. 4,248,200) and Waggoner *et al.* (U.S. Patent No. 6,218,706); claim 10 stands rejected under 35 U.S.C. § 103(a) over Edholm and Dean *et al.* as applied to claim 1 above, and further in view of Bertin *et al.* (U.S. Patent No. 6,097,243); claims 11 and 26-28 stand rejected under 35 U.S.C. § 103(a) over Edholm and Dean *et al.* as applied to claims 1 and 25 above, and further in view of Mason *et al.* (U.S. Patent No. 6,727,451); claims 12 and 15-18 stand rejected under 35 U.S.C. § 103(a) over Edholm and Dean *et al.* as applied to claims 1 and 13 above, and further in view of Maeda *et al.* (U.S. Patent No. 5,884,074); claim 20 is rejected under 35 U.S.C. § 103(a) over Edholm in view of Dean *et al.*, and further in view of Dean (U.S. Patent No. 5,553,276); and claims 21-22 stand rejected under 35 U.S.C. § 103(a) over Edholm and Dean '326 as applied to claim 20 above, and further in view of Adelman (U.S. Patent No. 5,598,362).

Applicant appreciates Examiner's allowance of claim 23.

As the Final Office Action repeats (apparently *verbatim*) the above claim rejections as indicated in the previous Office Action mailed on March 28, 2005, Applicant fully incorporates herein the remarks made with the Office Action Response filed on June 28, 2005 (and others of record), pointing out the impropriety of all of the claim rejections. Notwithstanding the above, the Applicant has addressed certain claim rejections and the Examiner's Response in an effort to emphasize certain improprieties of the rejections.

All of the claim rejections are made under Section 103(a) and rely upon the primary '269 (Edholm) reference, as modified in view of the '326 (Dean) reference and in view of the Examiner's representation of "well known" prior art. In an attempt to arrive at the claimed limitations, the Examiner cited disparate portions of the '269 reference and combined these portions into asserted components, including an IP network stack and a communications stack, without showing how these portions are combined on a common chip and work together as claimed and without showing evidence in support of such combination. In this regard, all of the claim rejections are improper because each relies upon the primary '269 reference and the (improperly) alleged teachings therein, alone or in connection with other references, and because the Examiner has failed to cite evidence in support of the proposed modification of the '269 reference.

In the Response to Arguments section beginning on page 24 of the Final Office Action, the Examiner alleges that "stacks or layers, as it well know [sic] in the art, are basically software application/codes/process" that correspond to claimed limitations including an "IP network stack" and a "communications stack." The Examiner further alleges that "it is clear that the IP network stack and a communication stack are software components/codes, which can be embodied anywhere." Applicant submits that these assertions, in particular that such components can be embodied "anywhere," are not only improper in view of well-known art (including that provided to the Examiner by the Applicant), they lack evidentiary support and fail to show how the portions of the '269 reference would be combined as such in order to correspond to the claimed limitations.

For example, Exhibit A in the Office Action Response filed on June 28, 2005 describes a stack as implemented in hardware and software; this contradicts the Examiner's conclusion that such stacks are software that can be embodied anywhere. In addition, the Examiner's suggestion that the disparate functions of the '269 reference can be embodied anywhere fails to teach or suggest the particular combination set forth in the claimed limitations, and further fails to show how the functions/components of the '269 reference could be embodied together on a chip. As suggested by the Examiner on page 25 of the Final Office Action, there must be rules indicating how the various components interoperate, yet the Examiner has failed to show exactly what these rules are and their

interoperability with the '269 reference. That is, the Examiner has failed to show how

the various components (packetizer 334, controller 314, memory 332 and extractor 322)

interoperate and are embodied on a common chip in a manner consistent with the claimed

limitations. The Examiner's allegation that the cited portions of the '269 reference are

"basically software application/codes/process" that can be embodied "anywhere" fail to

show how the disparate portions of the '269 reference could work together in a manner

that corresponds to the claimed limitations.

Specifically addressing the Examiner's Response to Arguments on page 26 of the

Final Office Action, the Examiner's alleged support for asserting that the '269 reference

teaches an IP network stack as claimed is limited to the following discussion:

> Edholm's combined system of Packetizer 334, memory 332, and Extractor 322
> has a functionally [sic] of IP network stack software/method/processes. Another
> [sic] word, IP network stack is embodied in a combined system of Packetizer 334,
> memory 332, and Extractor 322 since they both have identical functionality.

Applicant submits that this alleged support fails to address the requirement in the claimed

limitations include an IP stack, in that the Examiner stopped short of showing how the

above combination is an IP stack or of describing how such a stack would be

implemented with the alleged functionality. For example, the Examiner cited no

evidence from the '269 reference or the prior art that suggests that such components

could be implemented in an IP network stack, much less on a common chip. Further, if

the Examiner is asserting (as apparently so) that all of these functions (packetizer 334,

memory 332, extractor 322) are software-embodied functions, it is unclear as to how such

functions would operate in accordance with an IP stack as claimed, and how the '269

reference would accordingly function.

Referring again to page 26 of the Final Office Action, the Examiner's alleged

support for asserting that the '269 reference teaches a communications stack as claimed is

directed to the following:

> Edholm's a [sic] combined system of Controller 314, Packetizer 334 and memory
> 332 has a functionally [sic] of communication network stack
> software/method/processes. Another [sic] word, communication stack is
> embodied in a combined system of Controller 314, Packetizer 334 and memory
> 332 since they both have identical functionality."

As with the improprieties associated with the alleged support for the IP network stack above, Applicant submits that the Examiner has not shown how the alleged functionality is identical to the claimed limitations, and has not described how the various components could function as a communication stack.

In view of the above, the Examiner's attempt to show correspondence (teaching or suggestion) between the '269 reference and various claimed limitations has failed. Therefore, all of the Section 103 rejections, each of which relies upon the improper interpretation of the '269 reference, are improper and should be removed.

Applicant further submits that the Examiner's apparent attempt to characterize the various components (*e.g.*, packetizer 334, memory 332, extractor 322 and controller 314) of the '269 reference as "software" and/or an "IP network stack" or "communication stack" is a modification of the primary reference that requires supporting evidence from the prior art. Instead of citing prior art that supports making such modifications, the Examiner has made broad conclusory statement, alleging that such a modification is "well-known." Apparently, the Examiner is also alleging that such a modification would inherently be implemented on a common chip. Without evidence from the prior art, Applicant submits that such allegations made with a hindsight view of the instant invention are improper and fail to establish a *prima facie* case of obviousness. In addition, any alleged inherency-type assertions by the examiner must be established by intrinsic evidence from the prior art. Applicant therefore submits that the Section 103 rejections should also be removed for these reasons.

Applicant also traverses the Section 103 rejections because the Examiner's proposed modification of the various components (*e.g.*, packetizer 334, memory 332, extractor 322 and controller 314) would appear to undermine the purpose of the '269 reference, including that directed to bi-directional communication. For example, as discussed in the Office Action Response filed on June 28, 2005, such bi-directional communication is in apparent contrast with the Examiner's assertion that such components are part of an IP network stack or communications stack. Relevant case law indicates that, where a proposed modification of a primary reference would undermine

the purpose of that reference, the modification is unmotivated. *See, e.g., In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984) (A §103 rejection cannot be maintained when the asserted modification undermines purpose of main reference).

Applicant further submits that the Examiner has failed to address and answer Applicant's traversals in a manner consistent with M.P.E.P. §707.07(f) and 35 U.S.C. §132. Specifically, the Examiner has not addressed Applicant's arguments directed toward the Examiner's incorrect interpretations of the '269 reference as indicated in the Office Action Response filed June 28, 2005. The text of these arguments is repeated below for convenience:

> The Office Action is incorrect where it states the IP network stack is the "combined system of packetizer 334, memory 332, and extractor 322" in *Edholm*. Packetizer 334 communicates bi-directionally with memory 332, and extractor 322 communicates bi-directionally with memory 332. *See* Fig. 3. For example, at column 6, line18, *Edholm* indicates that packetizer 334 communicates bi-directionally with memory where it states "[t]he packetizer then queries memory 332 for the desired destination IP address . . . and builds an IP packet header information using at least one of the returned destination IP addresses." Packetizer 334, memory 332, and extractor 322 in *Edholm* fail to correspond to Applicant's IP network stack as claimed.

> The Office Action is also incorrect where it states the communication stack is the "combined system of controller 314, packetizer 334, and memory 332," in *Edholm*. For example, memory 332 exports data and receives data from packetizer 334 and from controller 313. *See* Fig. 3. Because memory receives and exports data to both controller 314 and packetizer 334, the combined system of controller 314, packetizer 334, and memory 332 do not operate as a stack where each layer only uses functions of the layer below, and only exports functionality to the layer above. Therefore, the teaching of *Edholm* fails correspond to Applicant's communication stack as claimed.

As discussed above in connection with the discussion of the impropriety of the claim rejections, the Examiner failed to show how the packetizer 334, memory 332 and extractor 322 of the '269 reference function as the claimed IP network stack. In particular, the Examiner failed to address the Applicant's arguments directed to the Examiner's failure to show why the '269 reference's bi-directional communication corresponds to an IP network stack, or how such communication would be consistent with such a stack where the reference specifically requires otherwise. Further, the
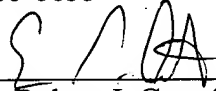
Examiner also failed to show (*e.g.*, via prior art references) how the various cited components in the '269 reference are an IP network stack. Similarly, the Examiner has failed to show how the controller 314, the (same) packetizer 334 and the (same) memory 332 also function as a communication stack as claimed. In doing so, the Examiner failed to even attempt to address the Applicant's traversal as directed to the above. Should the rejection be maintained (and, *e.g.*, proceed to Appeal), Applicant requests that the Examiner address the Applicant's arguments and answer the substance thereof in an effort to afford the Applicant an opportunity to judge the propriety of the rejection and provide and answer (if appropriate) to the same.

In view of the above discussion, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. A favorable response is requested. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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